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| 09/749,420 | 12/28/2000 | Naohito Takae | 1086.1129 | 5681 |
| 21171 | 7590 | 08/26/2004 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | DAVIS, TEMICA M | |
| | | | ART UNIT | PAPER NUMBER |
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DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,420

Applicant(s)

TAKAE ET AL.

Examiner

Temica M. Davis

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12 and 14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2,7,9-12 and 14 is/are rejected.
7) ☒ Claim(s) 3-6 is/are objected to.
8) ☒ Claim(s) 13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of the subject matter in claim 8 (now canceled and implemented in claims 1, 11 and 12) is withdrawn in view of the newly discovered reference(s) to Dahm et al (Dahm), U.S. Patent No. 6,301,471. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 9-12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Dahm.

Regarding claims 1, 11 and 12, Dahm discloses cellular phone managing method/apparatus/record medium comprising: (a user information generation unit for) generating and accumulating cellular phone user information (col. 7, line 38-col. 8, line 20); and (a specific user dealing unit for) dealing with a specific user by extracting a specific user conforming to predetermined conditions from said user information and for

dealing with a cellular phone of said extracted specific user in accordance with said extraction conditions, wherein said dealing comprises extracting a user who has paid charges as a good specific user from said user information and posting said cellular phone of said good specific user by mail on the provision of an incentive (col. 3, lines 53-59, col. 8, lines 26-43, col. 8, line 58-col. 9, line 27; figures 6A-6F).

Regarding claim 9, Dahm discloses a method according to claim 1, wherein said dealing comprises providing as said incentive any one selected from the group consisting of contents intended for good users (i.e., special offers), contents use free of charge service with time limit, a discount service with time limit, and points (col. 8, lines 26-43, col. 11, lines 1-19).

Regarding claim 10, Dahm discloses a method according to claim 1, wherein said generating user information containing contents use feature of a user from contents use information of said cellular phone and wherein said dealing includes providing contents intended for good users corresponding to said contents use feature to said cellular phone of said specific user (col. 8, lines 26-43, col. 11, lines 1-19).

Regarding claim 14, Dahm discloses a cellular phone monitoring method comprising providing cellular phone user information, identifying a user meeting predetermined conditions based on the cellular phone user information, and providing the identified user with an incentive electronically via the cellular phone (col. 7, line 38-col. 8, line 44).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm in view of O'Neil, U.S. Patent No. 6,226,364.

Regarding claim 2, Dahm discloses a method according to claim 1 as described above. Dahm, however, fails to disclose wherein said generating comprises generating user information containing charge arrears status from cellular phone receipt arrears information; and wherein said dealing comprises extracting a specific user from said user information on a delinquent period basis and issuing dunning and/or function restriction to a cellular phone of said specific user depending on the delinquent period.

In a similar field of endeavor, O, Neil discloses a method and system for providing prepaid and credit-limited telephone services. O'Neill further discloses generating user information containing charge arrears status from cellular phone receipt arrears information; and wherein said dealing comprises extracting a specific user from said user information on a delinquent period basis and issuing dunning and/or function restriction to a cellular phone of said specific user depending on the delinquent period (col. 1, lines 26-41).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Dahm with the teachings of O'Neil for the purpose of ensuring that a user who has broken a promise to pay (contract) loses communication services.

Regarding claim 7, the combination of Dahm and O'Neil discloses a method according to claim 2 as described above. The combination, however, fails to disclose wherein dealing comprises canceling said function restriction when payment of arrears is recognized during said cellular phone function restriction.

The examiner contends that such a feature, at the time of invention, would have been obvious to a person of ordinary skill in the art for the purpose of allowing a user to use communication services in the event that he/she is in good payment standing.

Allowable Subject Matter

6. Claims 3-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lee, U.S. Patent No. 5,839,063.

Boltz, U.S. Patent No. 6,131,024.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis
Examiner
Art Unit 2681

August 21, 2004


TEMICA M. DAVIS
PATENT EXAMINER